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Dated: April 27, 2007

Signature: Oliver Ong
(Oliver T. Ong)

Docket No.: 29488/36831A
(PATENT)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:

Michael BLESER et al.

Application No.: 09/852,501

Confirmation No.: 6411

Filed: May 10, 2001

Art Unit: 3692

For: METHOD OF SELLING GIFTCARDS

Examiner: FRANTZY POINVIL

APPELANT'S BRIEF IN REPLY TO EXAMINER'S ANSWER

MS Appeal Brief-Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

This paper is in response to the Examiner's Answer mailed February 27, 2007, in the above-identified application. This Reply Brief is filed within two-months of the mailing of the Examiner's Answer. Accordingly, this Reply Brief is timely filed.

This brief contains items under the following headings as required by 37 C.F.R. §41.37 and M.P.E.P. §1206:

- I. Real Party In Interest
- II. Related Appeals and Interferences
- III. Status of Claims
- IV. Status of Amendments
- V. Summary of Claimed Subject Matter
- VI. Grounds of Rejection to be Reviewed on Appeal
- VII. Argument – Reply to Examiner's Answer

Appendix A – Claims

Appendix B – Evidence

Appendix C – Related Proceedings

I. Real Party In Interest

No change.

II. Related Appeals and Interferences

No change.

III. Status of Claims

No change.

IV. Status of Amendments

No change.

V. Summary of Claimed Subject Matter

No change.

VI. Grounds of Rejection to be Reviewed on Appeal

Whether the cited references of Risafi et al., (U.S. Patent No.6,473,500) or Walker (U.S. Patent No. 6,193,155) disclose the recited element of designating a second retailer with whom a giftcard may be exclusively used.

VII. Argument – Reply to Examiner’s Answer**A. The Answer Contains An Improper Omnibus Rejection**

The Examiner’s Answer states that “designat[ing] the selected second retailers is not an inventive concept which should be accorded a patentable difference.” Examiner’s Answer, p. 7, lines 9-10. This appears to be the type of non-informative “omnibus rejection” specifically prohibited by Section 707.07(d) of the MPEP. Moreover, applicant’s note that this rejection apparently ignores the “exclusive use” limitation attached to the “designating” step in each of the pending independent claims. Applicants’ would be happy to respond to a rejection alleging that the relevant limitation fails to pass muster under Sections 101, 102, 103, or 112 of Title 35.

B. Walker Expressly Teaches Use At Any Retailer, And Thus, Teaches Away From Exclusive Use At A Designated Retailer

In order for the rejection to stand, we must either ignore the plain meaning of the limitation “for exclusive use” with a designated retailer, or we must ignore the plain language in Walker that expressly teaches unlimited, universal use at any location of the user’s choosing. The word “exclusive” suggests a limit, and that limit necessarily places a bar on the user’s activity. In turn, the user is restricted from using the giftcard at locations that are not included in the “designated” group of second retailers. Such a limit necessarily conflicts with the universal, inclusive language of Walker.

The gift certificate of Walker is universal and can be redeemed at multiple retailers at the choosing of the user. The very passage from Walker cited in the Examiner’s Answer in support of exclusion actually teaches against exclusion as follows:

Recipient 106 may then present the gift certificate to pay for goods and/or services at participating merchants, such as merchant 108. A participating merchant is one that is capable of processing credit card transactions on behalf of the credit card issuer designated on the gift certificate, such as gift certificate 820 more fully described with reference to FIG. 8.

Col. 5, lines 29-36. The Walker gift certificate is drawn against a credit card account. In turn, the redeeming merchant can be any merchant, as long as the merchant is capable of

processing a credit card transaction. Those of skill in the relevant art readily understand that credit card networks include more than one merchant or retailer, and in fact credit card transactions may be performed almost anywhere. Thus, the foregoing passage makes clear that the gift certificate of Walker can be redeemed at any location that is part of the credit card network.

In other words, Walker does not teach limiting or excluding use or redemption to "designated second retailers." Instead, Walker merely teaches that redemption may be performed anywhere, as long as the chosen retailer meets the single precondition of being capable of processing credit card transactions. Given that nearly all merchants or retailers satisfy this single precondition, Walker expressly teaches universal use, rather than limited use. The Examiner's Answer acknowledges that Risafi does not teach or suggest designating a second retailer with whom the giftcard may be exclusively used. Consequently, the cited combination does not teach or suggest all of the claim limitations, and therefore the Examiner's Answer fails to establish a proper *prima facie* case of obviousness.

C. Citing A Single Example In Risafi Does Not Prove Or Even Suggest That Risafi Is Limited To That Chosen Example, Especially In Face Of Numerous Universal Or Inclusive Examples

The Examiner's Answer cites the TELCO (telephone company) example in Risafi, and seems to suggest that the very existence of that example somehow establishes that Risafi teaches the exclusivity required by the pending independent claims. However, Risafi specifically teaches an instrument that is redeemable at more than one retailer without exclusion as follows:

The card user is able to use the card at **any** terminal or other designated device connected through a network to the processing center to buy goods and services, to withdraw cash, and to add value to the card.

(Emphasis added) Col. 4, lines 7-10. Like Walker, Risafi appears to have the simple precondition that the retailer merely be capable of processing credit transactions. Other passages support this inclusive notion:

The card user is then able to select a PIN of his or her choosing, and is able to use the card at **any merchant or terminal** (including different merchant terminals and automatic teller machines ("ATMs")) connected to a designated central processing center. Additionally, the

card is preferably reloadable so that the same card can be used over and over again.

(Emphasis Added) Col. 6, lines 41-45.

The Examiner makes the illogical leap that because the TELCO example exists, the TELCO example teaches exclusivity. In the face of the laundry list provided by Risafi (Col. 5, line 17), and in the face of the fact that the TELCO example is merely an example of one of many possible redemption options, the conclusion in the Examiner's Answer simply does not make sense. Plain and simple, Risafi fails to teach or suggest the exclusivity claimed by the independent claims, and in fact teaches seemingly universal redemption. Accordingly, Risafi expressly teaches the opposite of what is claimed by the pending independent claims. There is no suggestion to discard the expressly-taught universal aspect of the reference to arrive at a limited, exclusive arrangement. Therefore, Risafi cannot support a proper *prima facie* case of obviousness.

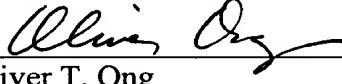
CONCLUSION

In view of the foregoing remarks, it is respectfully submitted that each of claims 1-18 is patentable over the prior art, and that all of the pending claims should be allowed.

The Commissioner is authorized to charge any fee deficiency or credit any overpayment to Deposit Account No. 13-2855.

Respectfully submitted,

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APPENDIX A – CLAIMS**Claims Involved in the Appeal of Application Serial No. 09/852,501**

1. (Previously Presented) A method for selling a disposable giftcard at a store location of a first retailer for exclusive use with a designated second retailer, the method comprising:

displaying a plurality of non-activated giftcards in the store location of the first retailer;

designating a second retailer with whom the giftcard may be exclusively used;

activating a selected one of the displayed giftcards for exclusive use with the designated second retailer upon receipt of a purchase amount from a customer;

forwarding information pertaining to the selected giftcard to a server computer associated with the second retailer; and

transferring proceeds from the first retailer to the second retailer in accordance with said information, the proceeds including at least a portion of the purchase amount.

2. (Original) The method of claim 1, further comprising calculating a revenue share of the purchase amount for the first retailer, in which the proceeds are equal to the purchase amount less the revenue share.

3. (Original) The method of claim 1, in which the giftcard has a preset credit value.

4. (Original) The method of claim 1, in which multiple sets of giftcards are displayed at the first retailer, each set of giftcards being redeemable at a different second retailer.

5. (Previously Presented) The method of claim 1, in which the server computer provided by the second retailer initiates said transfer of proceeds from the first retailer to the second retailer.

6. (Previously Presented) The method of claim 1, in which the server computer is provided by a third party associated with the second retailer.

7. (Previously Presented) A method for selling a disposable giftcard at a store location of a first retailer for exclusive use with a designated plurality of second retailers, the method comprising:

displaying a plurality of inactive giftcards in the store location of the first retailer; designating a plurality of second retailers with whom the giftcard may be exclusively used;

activating a selected one of the giftcards for exclusive use with the designated plurality of second retailers upon receipt of a purchase amount from a customer;

forwarding information pertaining to the activated giftcard to a server computer associated with the designated plurality of second retailers; and

transferring proceeds from the first retailer to the designated plurality of second retailers, the proceeds including at least a portion of the purchase amount.

8. (Original) The method of claim 7, further comprising calculating a revenue share of the purchase amount for the first retailer, in which the proceeds are equal to the purchase amount less the revenue share.

9. (Original) The method of claim 7, in which the giftcard has a preset credit value.

10. (Previously Presented) The method of claim 7, in which the plurality of second retailers comprise an outside retailers consortium, and in which the server computer is provided by the outside retailers consortium.

11. (Previously Presented) The method of claim 7, in which the plurality of second retailers comprises an outside retailers consortium, and in which the server computer is provided by a third party associated with the outside retailers.

12. (Previously Presented) A method of selling a disposable giftcard at a store location of a first retailer for exclusive use at a designated store location of a second and different retailer, the method comprising the steps of:

providing a giftcard to the store location of the first retailer, the gift card redeemable at the store location of the second and different retailer;

displaying the giftcard in an inactive state for purchase by a customer in the store location of the first retailer;

designating a store location of a second and different retailer at which the giftcard may be exclusively used;

activating the giftcard for exclusive use at the store location of the designated second retailer upon the receipt of a purchase amount from the customer;

forwarding information indicative of the activating step to a server computer, the server computer accessible by the designated second and different retailer; and

transferring at least a portion of the purchase amount from the first retailer to the designated second and different retailer.

13. (Previously Presented) The method of claim 12, wherein the first retailer comprises a first retail chain, and wherein the second and different retailer comprises a second retail chain.

14. (Previously Presented) A method of selling a disposable giftcard at a store location of a first retailer for redemption exclusively at a store location of a designated second and different retailer, the method comprising the steps of:

providing a giftcard for display and sale at the store location of the first retailer;

designating a store location of a second and different retailer at which the giftcard may be exclusively redeemed;

creating an activation record for the giftcard upon the receipt of a purchase amount from a customer;

storing the activation record in a server computer, the activation record accessible by the second and different retailer; and

making available for transfer at least a portion of the purchase amount from the first retailer to the second and different retailer;

issuing an active giftcard to the customer for exclusive use at the store location of the second retailer upon receipt of the purchase amount.

15. (Previously Presented) The method of claim 14, wherein the giftcard is provided by a third party, and wherein the activation record is accessible by the third party.

16. (Previously Presented) The method of claim 14, wherein the giftcard is provided by the first retailer.

17. (Previously Presented) A method comprising the steps of:
providing a store location associated with a first retailer;
providing the store location of the first retailer with a disposable gift card, the gift card designated by the first retailer for exclusive use with at least one designated store location of a second and different retailer;
displaying the giftcard for purchase by a customer in the store location of the first retailer;
activating the giftcard at the store location of the first retailer for exclusive use at the at least one designated store location of the second retailer upon receipt of a purchase amount from the customer;
creating an activation record associated with the giftcard upon activation of the giftcard, the activation record including an indication of the purchase amount received from the customer;
forwarding the activation record to a server computer, the server computer accessible by the second and different retailer; and

making at least a portion of the purchase amount available for transfer from the first retailer to the second and different retailer.

18. (Previously Presented) The method of claim 17, wherein the giftcard is associated with at least one store location of a plurality of additional and different retailers, the server computer accessible by the plurality of additional and different retailers, and wherein the portion of the purchase amount is available for transfer from the first retailer to a selected one of the plurality of additional and different retailers.

APPENDIX B – EVIDENCE

No evidence is submitted pursuant to 37 CFR § 1.130, 1.131 or 1.132.

APPENDIX C – RELATED PROCEEDINGS

There are no related proceedings.